REMARKS

Claims 20 and 22 are rejected under 35 U.S.C. §102(b) as being anticipated by Petrmichl et al. (U.S. Patent No. 5,618,619) ("Petrmichl") or Schmidt et al. (U.S. Patent No. 5,266,409) ("Schmidt"). The position of the Office in these rejections is that each of Petrmichl and Schmidt disclose "a carbon, hydrogen, silicon and oxygen containing film. The silicon carbide and silicon oxide is considered inherent."

It is respectfully submitted that the Office has not satisfied its burden of establishing a prima facie case of inherency. The burden of establishing a prima facie case of anticipation resides with the Patent and Trademark Office. As stated by the Board of Patent Appeals and Interferences in the case of *Ex parte Levy*, 17 USPQ2d 1461, 1463-64 (1990):

> "..., the initial burden of establishing a prima facie basis to deny patentability to a claimed invention rests upon the examiner. *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976); *Hansgirg v. Kemmer*, 102 F.2d 212, 40 USPQ 665 (CCPA 1939)." (Emphasis added).

In the present case, the Office has not provided any evidence or reasoning to support its position that the amorphous hard carbon claimed in the present application and composed mainly of carbon and hydrogen, and containing a silicon carbide and a silicon oxide, wherein the atomic % of the silicon bonded with carbon is greater than that of the silicon bonded with oxygen, is inherent in the Petrmichl and Schmidt references. The mere fact that the films of these references contain C, H, Si and O does not reasonably support the position of the Office. It is noted that U.S. Patent No. 5,352,493 to Dorfman et al., which is of record in the application, discloses films containing C, H, Si and O, but which do not include silicon carbide.

Moreover, neither of the references discloses the amounts of the carbon, hydrogen, silicon and oxygen in the films. (Petrmichl discloses only that the DLC materials of its invention can contain up to 50 atomic percent of hydrogen (Col. 5, line 67, to Col. 6, line 1)). The Office has not explained how either of the references can support a case of anticipation under 35 U.S.C. § 102 of claims requiring that a film be composed mainly of carbon and hydrogen and that the atomic % of the silicon bonded with carbon be greater than that of the silicon bonded with oxygen.

Removal of the 35 U.S.C. § 102 rejection is believed to be in order and is respectfully solicited.

Claim 23 is rejected under 35 U.S.C. §103(a) as being unpatentable over Petrmichl or Schmidt in view of Yamamoto et al. (U.S. Patent No. 4,783,368) ("Yamamoto") or DeVre et al. (U.S. Patent No. 5,569,487) ("DeVre").

The position of the Office in this rejection is that Petrmichl and Schmidt do not disclose the amount of silicon in the films disclosed therein. Yamamoto and DeVre are cited as teaching the claimed amount of silicon in a "hydrogenated carbon." (Action, page 3, line 2).

It is respectfully submitted that the Office has not satisfied its burden of establishing a prima facie case of obviousness. The issue raised by a rejection under 35 U.S.C. § 103(a) is whether there is a teaching, suggestion or motive provided by the prior art to modify the films of Petrmichl and Schmidt as proposed by the Office. The Office has not shown where the prior art provides the necessary teaching, suggestion or motive to modify the films of the primary references as proposed in the Action.

It is noted that Yamamoto is related to a heat conductive insulating substrate, and DeVre is related to a dielectric layer. I.e., the references are not related to wear-resistant DLC films.

Moreover, claim 23 depends on claim 20. Claim 20 is patentable for the reasons explained above. Claim 23, therefore, is prima facie patentable.

The foregoing is believed to be a complete and proper response to the Office Action dated November 7, 2003, and is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

In the event that this paper is not considered to be timely filed, applicant hereby petitions for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833. In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,
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